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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,930	04/20/2004	Trent J. Brundage	P0977	5107
23735	7590	09/01/2006	EXAMINER	
DIGIMARC CORPORATION 9405 SW GEMINI DRIVE BEAVERTON, OR 97008			CARTER, AARON W	
			ART UNIT	PAPER NUMBER
			2624	
DATE MAILED: 09/01/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/828,930

Applicant(s)

BRUNDAGE ET AL.

Examiner

Aaron W. Carter

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-16 is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/06</u>  | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. This action is responsive to papers filed on May 10, 2006.

#### ***Response to Amendment***

2. In response to applicant's amendment received on May 9, 2006, all requested changes to the claims have been entered.

#### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1 and 10 have been considered but are moot in view of the new ground(s) of rejection.
4. Applicant's arguments, see Remarks, page 6, filed May 9, 2006, with respect to claims 10 and 16 have been fully considered and are persuasive. The 35 USC 102(b) rejections of claims 10 and 16 have been withdrawn.

#### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "audio visual information" in line 5. There is insufficient antecedent basis for this limitation in the claim. It is indefinite as to whether the limitation is referring to audio, visual or a combination of audio and visual information. The examiner will treat the limitation as though it refers to either audio or visual information.

Claim 9 recites the limitation "audio visual information" in line 6. There is insufficient antecedent basis for this limitation in the claim. It is indefinite as to whether the limitation is referring to audio, visual or a combination of audio and visual information. The examiner will treat the limitation as though it refers to either audio or visual information.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 4-7 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5,859,920 to Daly et al. ("Daly").

As to claim 1, Daly discloses a method of processing a digitally watermarked media signal, the method comprising:

Receiving a watermarked media signal in a first device (Fig. 1, Fig. 12, element 96, column 5, lines 48-61 and column 10, lines 1-11, wherein the source image with embedded data corresponds to the watermarked media signal and element 16 of Fig. 1 corresponds to the first device that receives it);

Filtering audio or visual information of the watermarked media signal to leave a portion of the audio visual information representing a residual signal from which a digital watermark is decoded (Fig. 1, element 16, Fig. 12, column 5, lines 48-61 and column 10, lines 1-11, wherein cross-correlation corresponds to filtering the recovered data image corresponds to a residual signal);

Sending the residual signal to a remote system separate from the first device for extracting the digital watermark from the residual signal (Fig. 1, element 18 and column 5, lines 62-65, wherein system 18 is remote from the first device, element 16 and the digital data which corresponds to the digital watermark is extracted from the recovered data image).

As to claim 4, Daly discloses the method of claim 1 including:

Transforming the watermarked signal into a domain in which the digital watermark is embedded before sending the residual signal to the remote system (column 9, lines 31-36).

As to claim 5, Daly discloses the method of claim 4, including transforming the watermarked signal into a color space (column 9, lines 31-36).

As to claim 6, Daly discloses the method of claim 1, including:

Capturing the watermarked signal from a capture device (column 9, lines 11-15).

As to claim 7, Daly discloses the method of claim 6, wherein the capture device comprises a camera (column 9, lines 11-15).

As to claim 9, please refer to the rejection of claim 1 above.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Daly.

As to claim 8, Daly discloses method of claim 6. Daly does not disclose expressly the wherein the capture device is a microphone. However the process disclosed by Daly is generally applicable to any type of watermarked media signal. The examiner takes Official Notice that it is well known that watermarked signals are captured using a microphone. Therefore, it would have been obvious capture a watermarked media signal with a microphone.

***Allowable Subject Matter***

9. Claims 10-16 are allowed.

10. Claims 2 and 3 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

11. The following is an examiner's statement of reasons for allowance:

As to claims 10 and 16, none of the prior art teach or fairly suggest the limitation of "wherein progressively sending includes sending an increasing amount of the watermarked media signal to the remote system as necessary to achieve a successful decoding of a digital watermark from the watermarked signal", in combination with the other limitations of the claims. The prior art of Isnardi, already of record, discloses receiving a watermarked media signal in a first device (Fig. 6, MPEG bitstream), identifying portions of the watermarked media signal to send to a remote system for watermark decoding (Fig. 6, element 602 and column 2, lines 61-64) and progressively sending the portions of the watermarked media signal to the remote system (column 2, lines 64-65 and Fig. 6), but does not teach or fairly wherein progressively sending includes sending an increasing amount of the watermarked media signal to the remote system as necessary to achieve a successful decoding of a digital watermark from the watermarked signal as disclosed in claims 10 and 16.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

EP 0855829 A2 to Astola et al. discloses filtering an image and extracting a digital watermark.



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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron W. Carter whose telephone number is (571) 272-7445.

The examiner can normally be reached on 8am - 4:30 am (Mon. - Fri.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jingge Wu can be reached on (571) 272-7429. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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AWC

JINGGE WU  
PRIMARY EXAMINER